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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,471	03/24/2000	Kenneth A. Parulski	80724PRC	3331

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PATENT LEGAL STAFF
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EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/23/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/534,471Applicant(s)
ParulskiExaminer
O'ConnorArt Unit
2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Specification

1. The disclosure is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code. Applicant is required to delete all such embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01.
2. The specification is objected to as failing to comply with 37 CFR 1.74, which requires that, “When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter).”

Specifically, a “Figure 7” is described, but does not exist. Additionally, neither Figure 7A nor Figure 7B is described, though both exist.

Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: the blank spaces in the section concerning cross references to related applications should be updated with the proper application numbers or patent numbers.

Appropriate correction is required.

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Claim Objections

4. Applicant is reminded of the proper numbering of claims for original presentation in an application. Claims which depend from a dependent claim should not be separated by any other claim which does not also depend from the same dependent claim. In this case, however, as in general, applicant's incorrect sequencing will not be corrected until such time as the application becomes ready for passage to issue. See MPEP § 608.01(n).

5. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

When, as here, an independent claim recites a method of making a specified product, a claim to the product set forth in that independent claim is not a proper dependent claim if the product might be made in other ways, since the dependent claim could conceivably be infringed without infringing the basic claim, in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 7 and 17-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kitagawa et al. (US 5,819,126).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art described in the specification, in view of Kitagawa et al. (US 5,819,126).

The admitted prior art, as described by applicant, clearly anticipates all of the substantive elements of the instant invention with regard to a method of sales of customized products, except for disclosing that the particular customized product being offered for sale and selected/created by

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the customer in the manner of computer systems at dell.com is a camera system being sold for one time use (i.e. "leased"). The admitted prior art further allows that "sales" of such one-time-use (i.e. "leased") cameras is a conventional method in the art, for non-customized cameras.

Kitagawa et al. disclose a camera system which clearly anticipates all of the apparatus features of the instant camera system, as applied above under 35 U.S.C. 102(b), but Kitagawa et al. do not disclose a method of selling customized versions of their camera using a website, nor do they disclose "leasing" their camera (i.e. "selling" it for a one-time use or other limited use).

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known method of customized product sales of computers using a website such as dell.com, so as to sell camera systems instead of computer systems, such as the camera system of Kitagawa et al., with the customer selecting particular features in accordance with the known computer sales method, and selling the camera system for a one-time use (i.e. "leased"), as is conventional in the art for non-customized camera systems, so as to increase the profits of a company selling one-time-use cameras by reaching a wider market via the Internet, while satisfying a range of specific market niches by means of customization.

Regarding claims 12-15, storing a customer's photos as digital files and delivering those digital files by means of CD-R, e-mail, or allowing a customer to download the files from a specified Internet location, are all well known, hence, obvious method steps to follow in the art of photographic services. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of sales so as to convert the

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customer's photos into digital files and deliver those digital files by means of CD-R, e-mail, or allowing a customer to download the files from a specified Internet location, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, merely as a matter of design choice, in order to improve sales even further by offering customers even more photo options.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.
11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525.

GJOC



April 17, 2002



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